

## **REMARKS/ARGUMENTS**

Claims 1-64 are pending in the present application. Claims 1, 17, 33, and 49 are amended. The listing of the claims beginning on page 2 of this response replaces all prior versions, and listings, of claims in the application.

Applicants do not concede that the originally filed claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are included only to facilitate expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

### **I. 35 U.S.C. § 102, Anticipation**

The Board of Patent Appeals and Interferences has rejected claims 1, 17, 33, and 49 under 35 U.S.C. § 102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over *Dialog Pocket Guide* (2001) (hereinafter, “*Dialog*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-

obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).\

Applicants have amended claim 1. Amended claim 1 is as follows:

1. A method for extracting data from a data store comprising a first set of one or more data items, the method comprising the steps of:
  - creating a profile of the data store, the profile comprising a profile rule defining a profile set, wherein the profile set comprises a second set of one or more data items existing within the data store in accordance with the profile rule;
  - receiving a query of whether a third set of one or more data items is present within the data store;
  - responsive to receiving the query, creating a selected set comprising a third set of one or more data items in accordance with a selection rule;
  - responsive to a determination that an intersection of the selected set and the profile set is non-empty, extracting a fourth set of one or more data items from the data store in accordance with the selection rule; and
  - responsive to a determination that the intersection of the selected set and the profile set is empty, providing an indication that the data store does not include data items in the selected set.

#### **I.A. Dialog does not disclose the amended features of claim 1.**

In rejecting claim 1, the Board states the following:

Claim 1 is considered representative. Claim 1 does not appear to distinguish over well known database searching as evidenced, for example, by Dialog<sup>3</sup>. Dialog describes that the logical search operator AND performs an intersection between the results from two search terms. Page 4. A "selection rule" is a logical rule which describes the data items in the data store and can be a term, a term with proximity operators, terms with indexes, range searching, numeric searching, etc. (e.g., pages 3-11) that produces a "selected set." As a matter of claim interpretation, we conclude that a "profile rule" can be the same thing as a selection rule because it is also a logical rule that describes a set of items, a "profile set," from the data store. The claims do not recite how or when or by whom the profile rule is created so as to distinguish over a selection rule.

Consider the simple example on page 45. The limitation of "creating a selected set comprising a second set of one or more data items in accordance with a selection rule" reads on a level S1 search for the terms "disposable" adjacent to "diaper" which results in a selected set of 3,070 data items. The limitation "creating a profile of the data store, the profile comprising a profile rule defining a profile set, wherein the profile set comprises a third set of one or more data items in accordance with the profile rule" reads on a level S2 search for "market" within two words of "share" which results in profile set of 143,005 data items. The limitation "responsive to a determination that an intersection of the selected set and the profile set is non-empty, extracting a fourth set of one or more data items from the data store in accordance with the selection rule" reads on the intersection (AND operation) between level S1 and level S2 searches showing a non-empty set of 420 data items. The limitation "responsive to a determination that the intersection of the selected set and the profile set is empty, providing an indication that the data store does not include data items in the selected set" reads on the intersection (AND operation) between level S1 and level S2 searches where there are no items in common: that is, if S1 AND S2 is zero (not shown, but clearly possible with different data), there is an indication that the data store does not include items in common. Of course, the S1 search could correspond to a profile rule and the S2 search could correspond to a selection rule, instead of vice versa.

<sup>3</sup>The USPTO's EAST search system is similar but we do not have access to that documentation with the relevant dates.

Decision on Appeal, March 12, 2010, pp. 10-12.

The Board specifically stated that the Applicants' "profile rule" can be the same thing as a selection rule because it is also a logical rule that describes a set of items, a "profile set," from the data store. The Board goes on to say that the claims do not recite how or when or by whom the profile rule is created so as to distinguish over a selection rule.

In response to the new ground of rejection, and the Board's statements, the Applicants have amended claim 1. Amended claim 1 further defines how a profile rule is created, and how the selection rule is created, thus distinguishing the two rules. Thus, as a matter of claim interpretation, the Applicants submit that Dialog, and the Board's explanation, no longer anticipate, or alternatively no longer make obvious, amended claim 1. Withdrawal of the rejection is therefore requested.

Claims 17, 33, and 49 have been amended similar to claim 1. Therefore, the differences between the profile rule and the selection rule, as defined in the amended claims, are equally

applicable to claims 17, 33, and 49. Withdrawal of the rejection of claims 17, 33, and 49 is therefore also requested.

The remaining claims depend from one of claims 1, 17, 33, or 49. By reasons similar to those presented above, and by virtue of their dependence from the respective independent claims, *Dialog* does not disclose each feature of claims 2-16, 18-32, 34-38, and 50-64. Therefore, *Dialog* does not anticipate claims 2-16, 18-32, 34-38, and 50-64 under 35 USC 102(b). Alternatively, *Dialog* does not make obvious claims 2-16, 18-32, 34-38, and 50-64 under 35 USC 103(a). Withdrawal of the rejection is therefore respectfully requested.

## **II. Conclusion**

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/Brandon G. Williams/

Brandon G. Williams  
Reg. No. 48,844  
Yee & Associates, P.C.  
P.O. Box 802333  
Dallas, TX 75380  
(972) 385-8777  
Attorney for Applicants